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-- REMARKS --

Claims 1-23 remain under consideration and claims 24-27 have been added. No new matter has been added with the amendments to claims 1, 12 and 21, or with the addition of claims 24-27. Applicants thank the Examiner and her supervisor for their courtesies in the telephonic interview of July 27, 2004, but regret that interview was not successful in reaching agreement. During the interview, Applicants' counsel and the Examiner discussed at length the differences between the claimed invention and the references and proposed claim amendments were discussed.

A. The Examiner rejected claims 1-23 as anticipated under 35 U.S.C. §102(e) by Beelitz

The §102(e) rejection of claims 1-23 is traversed. In order to maintain this §102(e) rejection, each and every element of the claimed invention must be disclosed in as great detail by the reference. Because the reference does not disclose each and every element, this rejection must fall.

At a minimum, Beelitz does not disclose "a method of dynamically creating a list of operating systems for a target device in communication with a server prior to executing an operating system on the target device," as claimed in independent claim 1. Similar limitations exist in claims 12 and 21.

Per MPEP §2111.02, the preamble of a claim is to have "the import that the claim as a whole suggests for it. In claim 1, the claim as a whole suggests the limitation that the target is a remotely booted device, and Beelitz does not disclose this element. Beelitz is addressed to a problem facing computer manufacturers – how to install operating systems on computers that are being assembled. Beelitz discloses a method of installing operating systems for target computers that will be separated from the network, shipped to an end user, and then booted. *See, inter alia*, the Abstract of Beelitz, disclosing a "system for specifying, ordering, and building a build-to-order computer system."

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In contrast to the Beelitz disclosure, the instant case addresses problems faced by network administrators with target devices that are remotely booted on a network.

However, in an effort to expedite prosecution, Applicants have amended the preambles of claims 1, 12 and 21 to more precisely claim the invention. Applicants have not amended the claims to avoid any reference – rather, the amendment is to more clearly point out the invention. In any event, Beelitz does not disclose that the target device [is] to be remotely booted by the server, and therefore cannot anticipate the instant invention.

Withdrawal of the rejections to claims 1, 12 and 21 is requested. Claims 2-11, 13-20 and 22-23 depend directly or indirectly from claims 1, 12, and 21, and therefore withdrawal of the rejections to these claims is also requested.

Additionally, Applicants note that the Examiner's repeated allegations of the "teachings" of Beelitz are not germane to the disclosures of Beelitz, under §102(e). A §102(e) rejection must be premised on the *disclosures* of a reference, rather than the *teachings* of the reference.

In light of the Examiner's usage of §103(a) terminology, Applicants note that Beelitz cannot render obvious the claimed invention. In order for the Examiner to sustain an obviousness rejection, the reference must teach or suggest each and every element of the claims, and the reference must be analogous art.

First, Beelitz does not teach that the method is executed on a network to remotely boot the target, and therefore cannot render the claimed invention obvious, either as amended, or prior to amendment.

Second, by teaching a system for constructing build-to-order computing systems, Beelitz unequivocally teaches away from the instant invention. By permanently installing a single operating system on the target device, Beelitz forecloses on a network deciding on an operating system for the target immediately prior to booting the target. That is to say, after Beelitz installs an operating system upon its target, the installed operating system remains

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installed (most likely, until it is deliberately uninstalled, although this is not taught/suggested by Beelitz). To the contrary, the instant invention allows for a networked computer to be booted with different operating systems on successive boots.

B. Claims 24-27 are patentable

Claims 24-27 are patentable over the prior art, as the prior art alone or in combination fails to disclose, teach or suggest the preamble of claim 24, as argued above with reference to claim 1. Furthermore, the prior art fails to disclose, teach or suggest, selecting a preferred operating system for the target device from the comparable operating systems list, and executing the operating system on the target device, as claimed in claim 24. Claims 25-27 depend from claim 24 and are therefore patentable over the prior art for at least the same reasons.

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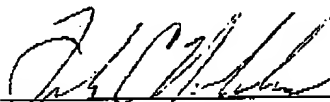
CONCLUSION

The Applicants respectfully submit that claims 1-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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